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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,206	12/20/2001	Caimi Luigi	08719.0196	6089

7590 09/25/2003

Finnegan, Henderson, Farabow  
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Washington, DC 20005-3315

EXAMINER

JACKSON, MONIQUE R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

10/022,206

Applicant(s)

LUIGI ET AL.

Examiner

Monique R Jackson

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The preliminary amendment filed 12/20/01 has been entered. Claims 1-21 have been canceled. New claims 22-42 have been added. Claims 22-42 are pending in the application.

#### *Claim Objections*

2. Claims 27, 28, 30, 38, 39, and 41 are objected to because of the following informalities: though alternative expressions are permissive in the claims, they should be drafted in proper alternative format, i.e. “**selected from A, B or C**”; or in proper Markush claim format, i.e. “**selected from the group consisting of A, B and C**”. A claim that recites “selected from A, B, and C” as in the instant claims is improper alternative format.

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 33-42 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/00288 (WO'288.) WO'288 teaches a thermoplastic elastomer composition comprising an elastomer terpolymer having the following composition: a) 40-90mol%, preferably 50-90mol% ethylene; b) 10-60mol%, preferably 10-50mol% alpha-olefin, preferably propylene; and c) 0.2-5mol%, preferably 0.2-3mol% vinyl norbornene; wherein the terpolymer has a branching index of below 0.6, preferably 0.1-0.3; a molecular weight distribution above 6; a Mooney viscosity generally greater than 10, preferably 10-90; and wherein the vinyl norbornene may be 5-vinyl-2-

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norbornene as instantly claimed. WO'288 further teach the composition further comprises a crystalline or semi-crystalline thermoplastic such as polypropylene or polyethylene wherein the polyethylene has a density range of from 0.86 to 0.97g/cc (*which includes VLDPE and LDPE as in instant claim 18*) in an amount of from 10 to 900 phr, preferably 20 to 100phr (*reads on the instantly claimed range of less than or equal to 30 as recited in instant claim 17*), and may further comprise 0-30wt% additives including zinc oxide (*reads on the instantly claimed range of less than 10phr as recited in instant claim 15 and between 3 and 8phr as recited in instant claim 16.*)

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of WO'288. The admitted prior art teaches an electric cable for medium or high voltage electric energy transportation or distribution comprising at least one conductor and at least one insulating layer or one or more coverings formed of a crosslinked polymer material or elastomer but does not teach that the coverings or insulating layer comprise the instantly claimed elastomer composition. However, as discussed above, WO'288 teaches an elastomer composition that reads upon the instantly claimed composition wherein WO'288 further teach that the composition provides improvements in terms of mechanical properties such

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as compression set resistance with respect to other thermoplastic elastomers or vulcanized rubbers and may be utilized in producing various fabricated articles including tubing, seals, and extruded profiles (Abstract; Pages 1-3; Page 15, lines 8-11.) Hence one having ordinary skill in the art at the time of the invention would have been motivated to utilize the elastomer composition taught by WO'288, having improved cure and mechanical properties, as the polymer insulating layer in the invention taught by the admitted prior art.

7. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of WO'288 and in further view of EP 0 893 802 A1 (EP'802.) The teachings of the admitted prior art in view of WO'288 are discussed above. Though the admitted prior art teaches that the electric cable includes one or more coverings including an insulating layer, the admitted prior art does not teach the incorporation of at least one insulating layer and at least one layer including the polymer composition and a conductive filler to provide semiconductive properties. However it is well known in the art that an electric cable for medium voltages typically comprises insulating and semiconductor layers as taught by EP'802 (Page 2, lines 3-40; Page 3, lines 33-53; Figure 1) wherein the semiconductor layer(s) include a conductive filler dispersed therein to provide semiconductive properties to the layer(s). Hence, it would have been obvious to one having ordinary skill in the art to include conductive filler in one of the covering layers taught by the admitted prior art in view of WO'288 to incorporate conductive filler in at least one of the polymer covering layers of the invention taught by the admitted prior art in view of WO'288 to provide semiconductive properties to at least one of the coating layers as is typical and well known in the art as taught by EP'802.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428.

The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
**MONIQUE R. JACKSON**  
**PRIMARY EXAMINER**

Technology Center 1700  
September 22, 2003